

### **Remarks**

Applicants thank the Examiner for examining the claims of the present application and finding that claims 3-10, 41-43, and 45-46 contain allowable subject matter. By this amendment, applicants are canceling claims 1-2, 11-14, 16-27, 29-40, 44, 48, and 50-60 for purposes of expediting prosecution of this application. Claims 1-2, 11-14, 16-27, 29-40, 44, 48, and 50-60 have been rejected either under 35 U.S.C. § 103(a) or under 35 U.S.C. § 102(b) based upon certain applied references. All rejections of these claims are respectively traversed. Applicants reserve the right, however, to pursue the canceled claims in a continuing application. Applicants are also amending claims 3-7, 10, 28, 41-42, 45-47, and 49 to be in independent format and to recite all of the features of their respective base claims and any respective intervening claims. Applicants are adding new claims 61-82, which contain no new subject matter and comprise previously presented claims rewritten to depend from claims now written in independent format. Similarly, applicants are amending previously presented claim 15 to depend from amended claim 3 and to recite the features of intervening claim 13. With entry of this amendment, claims 3-10, 15, 28, 41-43, 45-47, 49, and 61-82 will be pending in the application.

Applicants respectfully request reconsideration of the Examiner's objections to claims 3-10, 41-43, and 45-46, and rejections of claims 15, 28, 47, and 49 in view of the following remarks.

### **Examiner interview of July 20, 2004**

A summary of the Examiner interview is attached as Exhibit A.

### **Allowability of claims 3-10, 15, 28, 41-43, 45-47, and 49**

At the outset, applicants note that the Office action of April 30, 2004, provides no basis for rejecting claims 6-10. As confirmed by the Examiner during the Examiner interview (see Exhibit A), claims 6-10 contain allowable subject matter.

In the Office action, the Examiner further indicates that claims 3-5, 28, 41-43, and 45-46 contain allowable subject matter. Also, the only rejection of claims 15, 28,<sup>1</sup> 47, and 49 is an

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<sup>1</sup> Applicants note that the Examiner indicates that claim 28 contains allowable subject matter but also rejects claim 28 for obviousness-type double patenting.

obviousness-type double patenting rejection, which has been overcome as explained below. Therefore, these claims contain allowable subject matter.

Applicants are amending claims 3-7, 10, 28, 41-42, 45-47, and 49 to be in independent format and to recite all of the features of the respective base claims and any respective intervening claims. Similarly, applicants are amending previously presented claim 15 to depend from amended claim 3 and to recite the features of intervening claim 13.

Therefore, claims 3-10, 15, 28, 41-42, 45-47, and 49 are now in condition for allowance and such action is respectfully requested.

**Rejection of claims 15, 28, 47, and 49 for obviousness-type double patenting over U.S. Patent No. 6,684,358**

It is first noted that the claims of U.S. Patent No. 6,684,358 are of a different scope than claims 15, 28, 47, and 49. For instance, the claims of the '358 patent all recite "a pseudo-random phase of operation" not found in any claims of the present application. Because the allegedly conflicting claims are not coextensive in scope, the Examiner's rejection cannot be based on the statutory type of double patenting, and therefore must be of the obviousness type. (See MPEP 804.II.A and 804.02.)

It should also be noted that the present application was filed on July 20, 2000, and claims the benefit of a provisional application filed on November 23, 1999, under Section 119(e), whereas the '358 patent issued from an application filed on November 15, 2000, which also claims the benefit of a provisional application filed on November 23, 1999. Because the filing date of the '358 patent is after the filing date of the present application, there does not currently appear to be any possibility of an unjustified extension in the patent term of any patent resulting from the current application.

Nonetheless, solely to facilitate prosecution of the present application, a terminal disclaimer is being submitted herewith to overcome the Examiner's obviousness-type double patenting rejection of claims 15, 28, 47, and 49. A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. (See MPEP 804.02.) Applicants note, however, that the filing of the attached terminal disclaimer is not an admission of the propriety of the rejection. (See MPEP 804.02.)

### **New Claims 61-82**

Applicants are adding dependent claims 61 to 82. Claims 61 to 82 comprise previously presented dependent claims that have been amended to depend from several of the newly rewritten independent claims. Specifically, claims 61, 62, 63, and 64 are identical to previously presented claims 13, 14, 16, and 17, respectively, but now depend from claim 3. Claims 65, 66, 67, and 68 are also identical to previously presented claims 13, 14, 16, and 17, respectively, but now depend from claim 4. Claims 69, 70, 71, 72 are also identical to previously presented claims 13, 14, 16, and 17, respectively, but now depend from claim 5. Claims 73, 74, 75, 76 are also identical to previously presented claims 13, 14, 16, and 17, respectively, but now depend from claim 7. Claims 77, 78, 79, 80 are also identical to previously presented claims 13, 14, 16, and 17, respectively, but now depend from claim 10. Claims 81 and 82 are identical to previously presented claim 33, but now depend from claims 47 and 49, respectively.

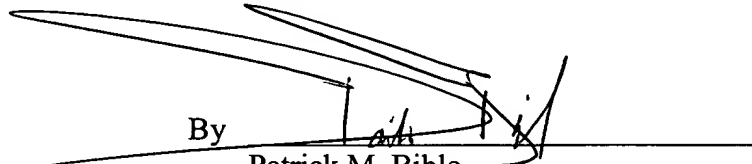
Because claims 61-82 all depend from base claims containing allowable subject matter, claims 61-82 are also allowable. These claims also set forth independently patentable subject matter.

**Conclusion**

For the reasons stated above, it is believed that the application is in condition for allowance, and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is invited to call the undersigned to discuss such matters.

Respectfully submitted,

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## **Exhibit A**

### **Examiner Interview Summary**

Applicants thank Examiner Chung for participating in a telephonic interview on July 20, 2004, and respectfully present the following summary of the substance of the interview.

The telephonic interview of July 20, 2004, included David P. Petersen and Patrick M. Bible (Reg. No. 44,423) as participants. During the interview, Applicants discussed U.S. Patent No. 5,167,034 ("MacLean, Jr. et al."), the article referenced in MacLean, Jr. et al. entitled "An Introduction To Arithmetic Coding," by Glen G. Langdon, Jr., IBM Journal of Research and Development, Volume 28, Number 2 (March 1984) (the "IBM article"), and the article entitled "Test Data Decompression for Multiple Scan Designs with Boundary Scan," by Rajski et al., 47 IEEE Transactions on Computers (November 1998) (the "Rajski article").

During the interview, Examiner confirmed that claims 6-10 contain allowable subject matter as no basis for rejection was provided in the Office action.

Applicants discussed their position that MacLean, Jr. et al. in combination with the Rajski article does not teach or suggest all of the elements in the rejected claims (and, in particular, claims 1 and 56). Agreement with respect to the rejected claims was not reached.